Application No.: 09/895,532
Amendment dated June 28, 2005
Reply to Office Action of March 28, 2005

REMARKS/ARGUMENTS

The non-final Office Action of March 28, 2005 (hereinafter the Action) has been carefully reviewed and these remarks are responsive thereto. By the present amendment, claims 1, 5, 7-10, 15, 17-20, 23, 24, 26, 29-32, 34-37, 40, 41, 46, 48, and 50 are amended and claims 4 and 39 are cancelled without prejudice or disclaimer. No new matter has been added. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 1-10, 20-28, 30, 32-34, and 37-41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,321,267 to Donaldson, et al. (hereinafter *Donaldson*). Applicant respectfully traverses this rejection for at least the following reasons.

In order to reject a claim as anticipated under 35 U.S.C. §102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02. However, *Donaldson* does not teach or suggest all the limitations of any rejected claim, as discussed in detail below.

Amended independent claim 1 recites:

> A method suitable for use in a communication device for determining the disposition of incoming e-mail from a sender, said method comprising the steps of:
> establishing the identity of the sender to provide a sender identifier;
> determining a cumulative penalty count value associated with said sender identifier, wherein determining said cumulative penalty count value comprises assessing a penalty count value to said sender identifier for an undesirable activity performed by the sender;
> retrieving a system overall resource usage status associated with the communication device; and
> processing the incoming e-mail on the basis of said cumulative penalty count value and said system overall resource usage status.

The Action states that *Donaldson* determines a cumulative penalty count value associated with said sender by determining a threshold number of match points. Furthermore, the Action states that if the value of the match point exceeds the threshold, there is an undesirable activity associated with the remote host. The Action misstates the workings of the reference, and fails to show the claim elements alleged.

Donaldson provides an email filter which examines the hostname of the SMTP server sending an email. *Donaldson*'s filter "compares the name of the connecting host with its immediate neighbors, using a heuristic approach to correlate a sequence of names as dialups or non-dialups." (Col. 21, lines 3-6) There is no undesirable activity performed by the sender alleged in *Donaldson*. There is merely a match point system used to characterize a sender as a dialup which might then be *suspected* of undesirable activity. Stated another way, there is no count in *Donaldson* that changes based on how many times or how severely a spammer performed an undesirable activity. *Donaldson* does not teach or suggest the use of a cumulative penalty count value found in amended claim 1.

The Action further indicates that *Donaldson*, at column 6, lines 42-52 and at column 16, lines 12-29, performs retrieving a system overall resource usage status associated with the communication device. The communication device referred to in the claim is the device which performs the method recited in amended claim 1 to process incoming email. However, *Donaldson* provides merely for "deallocat[ing] the resources (sockets, memory buffers, etc.) used for the message exchange and reset[ting] internal state variables to indicate that the message is no longer active." (Col. 16, lines 16-19) *Donaldson* does not provide for "retrieving a system overall resource usage status." There is no retrieving and there is no system overall resource usage status retrieved, merely the deallocating of resources and resetting of state variables associated with a single email message.

The Action also states that *Donaldson*, at column 22, lines 28-33 and column 16, lines 12-64, processes the incoming e-mail on the basis of said cumulative penalty count value and said system overall resource usage status. However, there are several flaws in the Action's analysis: (1) because *Donaldson* does not use a cumulative penalty count value as claimed, *Donaldson* cannot process incoming e-mail based on the system resource usage status; (2) because *Donaldson* similarly does not retrieve a system overall resource usage status associated with the communication device, *Donaldson* cannot process incoming e-mail based on the system overall resource usage status; (3) the first portion of *Donaldson* cited by the Action (Col. 22, lines 28-33) discusses only processing email based on the previously discussed match point system, not processing the incoming e-mail on the basis of said cumulative penalty count value and said system overall

resource usage status, as claimed; and finally, (4) the second portion of *Donaldson* cited (Col. 16, lines 12-19) only discusses operations when an email message is successfully transferred. It does not teach or suggest processing the incoming e-mail on the basis of said cumulative penalty count value and said system overall resource usage status, as claimed.

To clarify some of the features discussed above, claim 1 has been amended. For at least the above reasons, amended claim 1 is allowable over *Donaldson*.

Independent claims 20, 26, and 37 have been similarly amended and are allowable for reasons similar to claim 1. Namely, that *Donaldson* does not teach or suggest a penalty count as claimed. As to claim 20, *Donaldson* also does not teach an overall resource usage value. In addition, with respect to claim 20, the Action does not identify portions of *Donaldson* that recite the structure corresponding to the means plus function portions of the claim.

With regard to independent claim 24, the claim has been amended merely to fix a typographical error, and is otherwise in original form. The Action alleges that Table 4 in Col. 23 of *Donaldson* somehow discloses a sender penalty count data structure for storing a current penalty count value associated with the sender. Allowing for the Action's improper assertion that a penalty count is somehow disclosed by *Donaldson*'s match point system, Table 4 does not represent a data structure of the invention. Instead, Table 4 is provided as an example to show the distance as correlated to an offset of the four nearest neighbors of a remote host (Col. 23, lines 30-32). Furthermore, even if Table 4 was a data structure of the invention, it is not used "for storing a current penalty count value associated with the sender." There are no point values in Table 4, merely IP Offsets and absolute distances. *Donaldson* does not disclose a sender penalty count data structure.

With further regard to claim 24, the Action alleges that *Donaldson* discloses a system resource usage status file for storing a current usage status value for device e-mail processing resources. The Action points to a discussion of IP address blacklists and whitelists which may be stored in a single linear file at column 17, lines 27-54. The files disclosed in *Donaldson* have *nothing* to do with system resource usage status for device e-mail processing resources, other than the use of the word "file." *Donaldson* does not disclose the system resource usage status file of claim 24, and further in light of the above discussion does not disclose all the elements of the claim.

Application No.: 09/895,532
Amendment dated June 28, 2005
Reply to Office Action of March 28, 2005

Dependent claims 2, 3, 5-10, 21-23, 25, 27, 28, 30, 32-34, 38, 40, and 41 are also allowable at least based on the allowability of the claims from which they ultimately depend. In addition, dependent claims 5, 8-10, 23, 32, 34, and 41 have been amended to reflect changes in their respective base claims.

In addition, with respect to claim 5, *Donaldson* does not teach or suggest both an activity penalty count and a time-dependent penalty count. The Action's argument that attempting to send a message 100 times suggests a time-dependent penalty count as claimed is without support. The Action already asserted that the cumulative penalty count value is disclosed by the match points used to assess whether a sender of email is a dialup, an assertion which Applicant traverses. Following that logic, an activity penalty count and a time-dependent penalty count would both have to be components of the match point system. *Donaldson*, however, does not teach or suggest either "activity match points" based on current undesirable sender activity or a "time-dependent match point" determined from previous undesirable sender activity. The mere fact that a sender attempts to send a message 100 times in no way teaches or suggests the use of a time-dependent penalty count.

With respect to claim 6, *Donaldson* does not teach or suggest said time-dependent penalty count comprises a zero value subsequent to a pre-established retention period. The Action states that this feature is disclosed by two IP addresses being XOR'ed and bit-shifted, with a resultant zero value triggering a filter. IP addresses do not constitute a time-dependent penalty count value. This is especially so given that the Action has previously stated the penalty counts are disclosed by the separate matching point system used to determine whether a sender is a dialup, again which Applicant denies. *Donaldson* has no penalty count component that reverts to zero after a certain time.

With respect to amended claim 7, *Donaldson* does not teach or suggest the use of a time-dependent decay factor to reduce the penalty count. The Action cites *Donaldson*'s mere addition or subtraction of match points, which is not the same as a time-dependent decay factor. Claim 7 has been amended to clarify this distinction. Dependent claims 30 and 40 have been similarly amended. Furthermore, *Donaldson* adds and subtracts points to the match point value which, as previously discussed, is not the same as a cumulative penalty count.

Application No.: 09/895,532
Amendment dated June 28, 2005
Reply to Office Action of March 28, 2005

With respect to claims 8, 9, 22, 23, 25, and 33, the Action cites individual portions of *Donaldson* that individually look similar to the claimed group members, *i.e.*, portions that recite the existence of a group member. However, each of these claims does not claim an abstract idea. That is, each claim is not directed to the existence of the group member in the abstract, but rather the inclusion of the group member in the claim as a whole, including the features of any base claims. The Action thus fails to consider the claims as a whole, and fails to consider what one of ordinary skill in the art would learn or take away from *Donaldson*. Thus, because *Donaldson* does not teach or suggest a cumulative penalty count, it cannot teach or suggest a cumulative penalty count based on an undesirable activity that is one of the group members in claims 8, 22, or 33. Furthermore, the portions of *Donaldson* which are cited by the Action do not disclose the undesirable activities being used to determine a penalty count (or even a match point, for that matter). Similarly, because *Donaldson* does not teach or suggest a system overall resource usage status as claimed, *Donaldson* cannot teach or suggest a system overall resource usage status that is a function of one of the group members in claims 9, 23, or 25. Furthermore, the portions of *Donaldson* cited by the Action do not disclose a usage status being derived from any of the purported system overall resources (or even the "internal state variables" of column 16 being a function of the resources listed).

With respect to claim 10, the Office Action states that *Donaldson*, at column 16, lines 15-19, teaches assigning an operating state to the communication device, said operating state being a function of said system resource usage status. The cited portion of *Donaldson*, however, only discusses closing a connection to a proxy when a message is sent successfully, which has no relation to a system resource usage status as claimed.

With respect to claims 27 and 28, the Action alleges that *Donaldson* discloses maintaining a behavior trace table entry for the e-mail sender, determining said previous sender penalty count from said behavior trace table, and updating sender behavior values in said trace table entry in response to receipt of a sender email. The Action specifically points to Table 3 of *Donaldson*, which provides a listing showing how a particular ISP sequentially named its hosts over a range of IP addresses, and the offset value used to derive the listing. Nothing in this table amounts to a "behavior trace table entry." For that matter, the table is not even maintained, as

Application No.: 09/895,532
Amendment dated June 28, 2005
Reply to Office Action of March 28, 2005

required by claim 27. The table is merely provided for the specification to show how nearby IP addresses are similarly named in dialup settings. Moreover, the table is certainly not updated to reflect current sender behavior, as required by claim 28. The Action alleges that the logging of a rejected connection amounts to updating the behavior values in the trace table entry of claim 27. But the trace table entry of claim 27 (Table 3) is not the same thing as an email rejection log. *Donaldson* does not teach or suggest the elements of claims 27 and 28.

With regard to claim 32, the Action alleges that a relay host keeping undelivered messages in its queue for up to a week somehow discloses a sender penalty count value being determined from undesirable sender activity occurring over a period of time. This rejection is spurious on its face. A rejected email being held for a week does not affect a sender penalty count value (nor does it affect the purported penalty count of the match point system, for that matter). *Donaldson* does not teach or suggest all the elements of claim 32.

With respect to claims 4 and 39, these claims have been canceled without prejudice or disclaimer, and their rejections have been addressed above in the discussion of their respective independent claims.

Rejections Under 35 U.S.C. § 103

Claims 11-13, 17, 42-44, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Donaldson* in view of U.S. Patent No. 6,502,135 to Munger *et al.* (hereinafter *Munger*). These rejections are respectfully traversed.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, there is no motivation or suggestion to combine *Donaldson* with *Munger*. The Action states that it would have been obvious to combine the references "to obtain to random rejection of undesirable email messages." However, this is not a motivation to combine the

Page 17 of 19

references. Rather, this purported motivation is the result of a combination taught by Applicant's own disclosure. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Action provide any evidence that the combination does not include knowledge gleaned only from Applicant's disclosure.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigourously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicant respectfully submits that that there is no motivation or suggestion to combine *Donaldson* with *Munger*.

In addition, even if combined, the combination does not teach or suggest all the limitations of any claim, because *Munger* does not cure the aforementioned deficiencies of *Donaldson*.

Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Donaldson* in view of U.S. Patent No. 6,507,866 to Barchi *et al.* (hereinafter *Barchi*). This rejection is respectfully traversed, as claim 29 is allowable at least based on the allowability of its respective base claim, and because *Barchi* does not cure the deficiencies of *Donaldson*. Furthermore, claim 29 has been amended merely to repair a typographical error.

Allowable Claims

Applicant notes with appreciation the indication of allowable subject matter in claims 14-16, 18-19, 31, 35, 36, 45-47, and 49-50. Applicant has not rewritten these claims in independent form because Applicant maintains that all claims are presently allowable based on the arguments and remarks presented herein. Furthermore, claims 18, 19, 31, 35, 46, and 50 have been amended merely to reflect changes in their respective base claims.

Application No.: 09/895,532
Amendment dated June 28, 2005
Reply to Office Action of March 28, 2005

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: June 28, 2005   By: /Ross Dannenberg/
                                             Ross Dannenberg
1001 G Street, N.W.   Registration No. 49,024
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001

RAD/CSW

Page 19 of 19